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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,276	06/12/2006	Masayoshi Son	SB-1003-US	5677
63908	7590	09/21/2009		
MAIER & MAIER, PLLC 1000 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER LAEKEMARIAM, YOSEF K	
			ART UNIT	PAPER NUMBER
			2614	
			MAIL DATE	DELIVERY MODE
			09/21/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/566,276

Applicant(s)

SON, MASAYOSHI

Examiner

YOSEF K. LAEKEMARIAM

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7 and 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 4-7 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forte et al. (US 7,162,020) in view of Li et al. (US 2004/0170160).

Regarding claim 1, Forte discloses a gateway device to be installed between a public telephone network and a private branch exchange (Col.2 lines 56-61 and fig.1, 14, 30 and 54; Forte shows on fig.1, gateway 30 installed between PSTN 54 and PBX 14) to which a plurality of extension telephones are connected, said gateway device (Col.6 lines 11-14), comprising: a public telephone network connection unit (Col.12 lines 10-16; Forte discusses network switching device, therefore network connection unit) configured to connect the extension telephones to said public telephone network on the outside of said private branch exchange (Col.4 lines 17-26, Col.12 lines 7-17 and fig.1, 12a-b, 14, 16); an Internet connection unit configured to connect the extension telephones to said internet on the outside of said private branch exchange (abstract lines 3-6, Col.2 lines 58-66 and fig.1, 12a-b, 14; Forte discusses a wireless connect unit which connect PBX to PSTN, therefore an internet connection unit); a connection switching unit configured to selectively connect either said public telephone network or the Internet to said private branch exchange (Col.4 lines 21-31 and Col.12 lines 11-21; Forte discusses network

switching device and suitable communication line, therefore connection switching unit); a detecting unit configured to detect the use condition of a communication line connected to said private branch exchange (Col.6 lines 49-63, Col.7 lines 3-20 and Col.8 lines 54-60; Forte discusses WC 230, therefore a detecting unit); A notification unit configured to transmit, to said public telephone network through said public telephone network communication unit (Col.6 lines 1-10), wherein said private branch exchange is configured to switchingly connect the plurality of extension telephones with a plurality of communication lines of said public telephone network (Col.12 lines 6-22 and fig.1, 12a-12b, 14), wherein said gateway device is provided for each of the plurality of communication lines of said public telephone network (Col.2 lines 56-63), and wherein, when the communication line connected to said private branch exchange through said gateway device is in use (Col.4 lines 17-34 and Col.8 lines 46-59), a different gateway device serves to make a connection by proxy in response to a connection request issued for said gateway device in accordance with said notification unit (Col.2 lines 54-61).

Forte discloses the invention set forth above except for the claimed “an outgoing call only setting signal which notifies said public telephone network that only calling is viable to said public telephone network and to inform said public telephone network that an incoming call cannot be responded, only outgoing calling being viable in a case where the communication line connected to said private branch exchange is in use”

Li discloses that it is well known to have an outgoing call only setting signal which notifies said public telephone network that only calling is viable to said public telephone network and to inform said public telephone network that an incoming call cannot be responded, only

outgoing calling being viable in a case where the communication line connected to said private branch exchange is in use (Paragraphs: 0017-0018 and 0040).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Forte, and modify to set the outgoing call only setting signal which notifies said public telephone network that only calling is viable to said public telephone network and to inform said public telephone network that an incoming call cannot be responded, as taught by Li, thus allowing the PSTN central office switch to support a particular PSTN media channel between a state wherein it is reserved for outbound calls only and a state wherein it can support both inbound and outbound calls, as discussed by Li.

Regarding claims 6 and 11, Forte discloses a private branch exchange system configured to switchingly connect between a public telephone network and a plurality of extension telephones, said private branch exchange system (abstract lines 3-12, Col.4 lines 1-11 and Fig.1, 12a, 12b, 16), comprising: a private branch exchange connected to the plurality of extension telephones (Fig.1, 12a-12b, 14) and configured to switchingly connect the plurality of extension telephones with a plurality of communication lines of said public telephone network (Col.4 lines 38-57 and Col.12 lines 23-32) on the outside of said private branch exchange (Fig.1, 14, 16, 50, 54); and a plurality of gateway devices provided for the plurality of communication lines of said public telephone network respectively (Col.2 lines 56-63), and configured to connect the extension telephones to said public telephones network on the outside of said private branch exchange (Col.4 lines 17-28 and fig.1, 12a-b, 14), each of said gateway devices comprising: a public telephone network connection unit (Fig.1; 34, 36, 54) configured to connect said an extension telephone to said public telephone network (Col.4 lines 17-28 and Col.6 lines 16-35;

Forte discusses office extension numbers, therefore extension telephone); on the outside of said private branch exchange (Fig.1, 12a-b, 14, 50 and 54);, an Internet connection unit (Fig.3, 14) configured to connect said extension telephone to the Internet (Col.4 lines 21-29 and Fig.3 12a, 12b, and 50) internet on the outside of said private branch exchange (Fig.1, 14 and 50); a connection switching unit (Col.6 lines 48-53 and Fig.3, 229) configured to selectively connect either said public telephone network or the Internet (Fig.3 16, 50 and 230) to said extension telephone (Col.4 lines 1-5 and Fig.3 12a, 12b, 16, 50); a detecting unit (Col.8 lines 46-59; Forte discusses WC 230, therefore a detecting unit) configured to detect a use condition of a communication line connected to said extension telephone (Col.8 lines 54-65; Forte discusses line port detecting activity of a call, therefore detecting use condition of a line); a notification unit configured to transmit, to said public telephone network through said public telephone network connection unit (Col.6 lines 1-10), a different gateway device serves to make a connection by proxy in response to a connection request issued for said one of said gateway devices in accordance with said notification unit (Col.2 lines 54-61) .

Forte discloses the invention set forth above except for the claimed “an outgoing call only setting signal which notifies said public telephone network that only calling is viable to said public telephone network and to inform said public telephone network that an incoming call cannot be responded, only outgoing calling being viable in a case where the communication line connected to said extension telephone is in use, wherein, when the communication line connected to said public telephone network through said private branch exchange of one of said gateway devices is in use”

Li discloses that it is well known to have an outgoing call only setting signal which notifies said public telephone network that only calling is viable to said public telephone network and to inform said public telephone network that an incoming call cannot be responded, only outgoing calling being viable in a case where the communication line connected to said extension telephone is in use, wherein, when the communication line connected to said public telephone network through said private branch exchange of one of said gateway devices is in use (Paragraphs: 0017-0018 and 0040).

Considering claims 2 and 7, Li further discloses a system wherein said notification unit notifies said public telephone network that an outgoing call process and an incoming call process are viable when the communication line connected to said private branch exchange comes to be in an unused state (Paragraphs: 0057, 0076 and fig.5).

Considering claims 4 and 9, Forte further discloses a system wherein an identifier generation unit configured to generate a caller identifier for identifying the extension telephone (Col.7 lines 3-8; Forte discusses ANI, therefore caller identifier) connected to said public telephone network through said private branch exchange (Fig.3 14) based on a control signal from the extension telephone (Col.7 lines 3-14; Forte discusses guest room extension, therefore extension telephone), and an intended recipient identifier for identifying a communication device of an intended recipient of the extension telephone (Col.7 lines 23-32; Forte discusses database maintains information concerning telephone extension, therefore recipient identifier); a conversion unit configured to perform a conversion between voice signals and packet signals relating to the communication for voice conversation (Col.11 lines 60-67 and Col.12 lines 1-10); and a packet transmitter receiver unit configured to transmit said packet signals to the internet

and to receive said packet signals from the Internet based on of said caller identifier and said intended recipient identifier (Col.4 lines 61-67 and Col.5 lines 1-10).

Considering claims 5 and 10, Forte further discloses a system wherein a determination unit configured to output said voice signals to said public telephone network without the conversion between voice signals and packet signals, depending upon said intended recipient identifier (Col.6 lines 64-67 and Col.7 lines 1-8).

Considering claim 12, Li further discloses a method comprising notifying said public telephone network that an outgoing call process and an incoming call process are viable when the communication line connected to said extension telephone comes to be in an unused state (Paragraph: 0079; Li discusses detecting a status of the user communication line and providing the information to the PSTN central office, i.e. notifying the PSTN that the communication line comes to be unused state).

Response to Arguments

3. Applicant's arguments filed on 06-11-2009 have been fully considered but they are not persuasive because the argued features, i.e. , a gateway device comprising a public telephone network connection unit configured to connect the extension telephones to said public telephone network on the outside of said private branch exchange, read upon Forte as Forte teaches and discloses a wireless connect unit which preferably serves as a gateway connected to a PSTN, connects telephones set 12a and 12b to the PSTN (Forte, Col.4 lines 38-43). In fig.1, 12a-b, 30; Forte shows the wireless connect 30 (gateway) connect the extension telephones 12a-b to the public telephone network (PSTN 54) outside of PBX (fig.1, 14). Applicant argued feature, i.e.,

the gateway device of the present invention installed between a private branch exchange and a public network or internet on the outside of the private branch exchange and the gateway device is located on the opposite side of the private branch exchange with respect to the extension telephones, shows clearly on Forte's prior art fig. 1, 12a-b, 14 30 and 54. Applicant's argued feature, i.e., a gateway device comprising a connection switching unit configured to selectively connect either said public telephone network or internet to said private branch exchange, also shows upon Forte as Forte discloses and shows in fig.1, 14, 30, 50 and Col.11 lines 56-67 and Col.12 lines 1-22. The applicant's argued features i.e., a gateway device that is provided for each of the plurality of communication lines of said public telephone network, and wherein the communication line connected to said private branch exchange through gateway device teaches and discloses upon Forte, as Forte discloses the wireless connect unit preferably serves as a gateway between the PBX and one or more remote communication devices (Col.2 lines 56-63); In fig.1, 14, 30, 50 and 54, Fort's also shows how gateway device 30 provided for each of the plurality of communications lines PSTN 54 and Internet 50 gateway 30 wherein the communication line connected to said private branch exchange 14 through gateway device 30. The applicant's argument i.e. Forte and Li et al. do not provide the motivation to perform the proposed modification of system and method described in Forte read upon the prior arts, as Forte discloses the WC 230 (gateway) detects that the PBX 14 has received a call and check in to determine the eligibility to receive the in-bound calls and place out-bound calls if it is valid user (Forte, Col.8 lines 60-65); Forte also discusses allowing to enhance conveniences of today's PBX networks (e.g. interoffice voicemail, direct extension dialing, etc.) to be available in today's society (Forte, Col.2 lines 23-27) and disclosing that the invention is not to be seen as limited by

the forgoing description (Forte, Col.12 lines 65-67), therefore Forte is provide a system and method which is open for modification and improvement.

As a result, the argued features were written such that they read upon the cited reference.

Conclusion

4. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YOSEF K. LAEKEMARIAM whose telephone number is (571) 270-5149. The examiner can normally be reached on Regular hours 8:30 am - 5:30 pm M - F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CURTIS KUNTZ can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melur Ramakrishnaiah/
Primary Examiner, Art Unit 2614

/YOSEF K LAEKEMARIAM/
Examiner, Art Unit 2614
09-16-2009